

REMARKS

The Examiner rejected Claims 1-5, 7, 8 and 12-14 under 35 U.S.C. § 103 as obvious over Malosh, US Patent No. 5,070,708, (hereinafter "Malosh") combined with Yasuda, US Patent No. 6,193,206, (hereinafter "Yasuda"). The Examiner stated:

"Malosh et al. teach a refrigerator comprising a refrigerator housing (32), a compressor (34) mounted to the housing. However, Malosh et al. do not teach a spring configuration mounting the compressor to the housing. Yasuda et al. teach a damped spring configuration capable of mounting a compressor to a housing and connecting at least one connecting point of the compressor to a connecting point of the refrigerator housing, the spring configuration having at least one individual spring element (14) and at least one additional oscillation-enabled element (13 or 15) configured to oscillate at a different resonant frequency than said individual spring element. It would have been obvious to one of ordinary skill in the art to have provided the spring configuration of Yasuda et al. in the refrigerator of Malosh in order to reduce vibrations."

As the Examiner admits, Malosh does "not teach a spring configuration mounting the compressor to the housing" and in fact Malosh is directed to a floating frame resiliently secured to a refrigerator frame and rigidly secured to a compressor housing and the compressor resiliently mounted in the compressor housing. Yasuda is directed to "an active vibration isolator which is suitable for cut-off and suppression of microvibrations of precision instruments, e.g., in a factory for manufacturing semiconductor or a factory for manufacturing products using a laser.

Clearly Malosh and Yasuda make no suggestion of any combination of their unrelated structures and even less a combination as claimed in independent Claims 1 and 12, both of which require:

a damped spring configuration mounting the refrigerator compressor to the refrigerator housing and connecting at least one connecting point of the compressor to a connecting point of the refrigerator housing and the spring configuration having at least one individual spring element and at least one additional oscillation-enabled element configured to

oscillate at a different resonant frequency than that of the individual spring element.

As the Examiner admits, Malosh does not address either a spring configuration or mounting of the compressor to the refrigerator housing with such a spring configuration.

In order to make up for this clear deficiency, the Examiner combines Malosh with Yasuda because the Examiner states that Yasuda teaches a spring configuration "capable of mounting a compressor to a housing and connecting at least one connecting point of the compressor to a refrigerator housing". Thus, the Examiner concludes that it would be obvious to **modify the refrigerator of Malosh** with the spring configuration of Yasuda.

It is well settled that almost all claimed inventions are but novel combinations of old features. The courts have held in this context, however, that when "it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation **in the prior art** to make the selection made by the applicant". Interconnect Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985) (emphasis added). "Obviousness can not be established by combining the teachings of the prior art to produce the

claimed invention, absent some teaching, suggestion or incentive supporting the combination". In re Bond, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). "Under Section 103 teachings of references can be combined **only** if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital et al., 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original). "Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be '**clear and particular.**'" Winner Int'l Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587, 202 F.3d 1340 (Fed. Cir. 2000) (emphasis added; citations omitted); Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 56 USPQ2d 1456, 1459 (Fed. Cir. Oct. 17, 2000). Applicant believes that there is no "clear and particular" teaching or suggestion in Malosh to incorporate the features of Yasuda, and there is no teaching or suggestion in Yasuda to incorporate the features of Malosh.

In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to

arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the applicants' disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988), *cert. den.*, 488 U.S. 825 (1988).

The Examiner has not provided any reason, let alone the requisite reason, why one of ordinary skill in the art would have been led to modify Malosh by adding the features of Yasuda or to combine Yasuda's and Malosh's teachings to arrive at the claimed compressor dampening invention. Further, the Examiner has not shown the requisite motivation from some teaching, suggestion, or inference in Malosh or Yasuda or from knowledge available to those skilled in the art.

It is significant that the Examiner failed to give any support for the proposition why one having ordinary skill in the art would make such a drastic change to the Malosh device. The rejection clearly provides a mere conclusion that "it would have been obvious to one of ordinary skill in the art to have provided the spring configuration of

Yasuda in the refrigerator of Malosh in order to reduce vibrations." But, no supporting reason is provided to bolster that conclusion. In fact, the conclusion is entirely unsupported by any argumentation at all. The Examiner's sole reason for arguing a motivation to substantially modify the Malosh device is because "it would have been obvious."

Applicant respectfully believes that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. .

. . The references **themselves** must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in the cited references. In fact, no support, justification, rationale, or reason is given to make such a conclusion.

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art

references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614,1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453,1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, **identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention.** See id.

Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d

163.5, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125,1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See In re Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). **Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto.** See In re Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. **Broad conclusory statements standing alone are not "evidence."** Id. When an Examiner relies on general knowledge to negate patentability, **that knowledge must be**

articulated and placed on the record. See In re Lee, 277

F-3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

No such support has been placed on the record by the Examiner, therefore independent Claims 1 and 12 are allowable over the references. Further the dependent Claims 2-5, 7, 8, 13 and 14 add additional structure also not disclosed by the references and also clearly should be allowable.

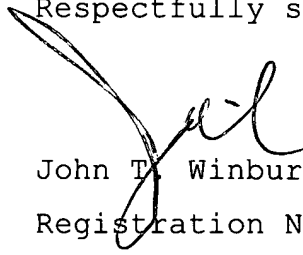
Claims 1-5, 7, 8 and 12-14 now remain in the application and should be allowable.

If the Examiner has any questions regarding this amendment, the Examiner is requested to contact the undersigned.

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Name of Attorney Signing

Respectfully submitted



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February 27, 2006

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